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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/760,169 | 01/12/2001 | Ursula Murschall | 00/002 MFE | 2792 |
| 38263 | 7590 | 11/26/2004 | EXAMINER | |
| PROPAT, L.L.C. | | | UHLIR, NIKOLAS J | |
| 425-C SOUTH SHARON AMITY ROAD | | | ART UNIT | |
| CHARLOTTE, NC 28211-2841 | | | PAPER NUMBER | |
| | | | 1773 | |

DATE MAILED: 11/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/760,169

Applicant(s)

MURSCHALL ET AL.

Examiner

Nikolas J. Uhlir

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-11, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-11 and 19-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. This office action is in response to the amendment/arguments dated 09/20/2004. Applicant's perfection of their priority claim renders the prior rejections utilizing GB2344596 untenable. Accordingly, the prior rejections utilizing this reference are withdrawn. However, the amendment is not considered to be sufficient to overcome the other prior art of record, as is clarified below.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-2, 4-6, 8, and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murschall et al. (DE19630599) in view of Zanucci et al. (U54265804) and Oishi et al. (U55936048).
4. Claim 1 has been amended to require the flame retardants to "consist essentially of" one or more organic phosphorous compounds. The examiner notes that absent a clear indication in the specification or the claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as "comprising" (see MPEP 21 1 1.03). Applicant in the instant case has not provided a clear description/statement of what the basic and novel characteristics of the instant invention. Accordingly, the examiner construes "consisting essentially of" in claim 1 as "comprising."
5. Bearing this interpretation in mind, the rejection of claims 1-2, and 4-8 are maintained as set forth in the prior office action dated 05/21/2004.

6. Regarding new claims 19 and 20. The limitations of these claims are met as set forth above for claims 1-2 and 4-8, with the following modification. It would have been obvious to one of ordinary skill in the art at the time the invention was made to 2-hydroxybenzophenone or 2-hydroxybenzotriazole as the U.V. Stabilizer in Murschall as modified by Zanucci and Oishi, in view of the fact that Murschall recognizes the equivalence of 2-hydroxybenzophenone or 2-hydroxybenzotriazole to the other U.V. stabilizers listed as suitable.
7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murschall as modified by Zanucci and Oishi as applied to claim 1 above, and further in view of Rakos et al. (US6251505).
8. This rejection is maintained as set forth in the prior office action dated 05/21/2004 and in view of the interpretation of "consisting essentially of" set forth above.
9. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murschall as modified by Zanucci and Oishi as applied to claim 1 above, and further in view of Schreck et al. (U55866246) and Kishida et al. (US5008313).
10. This rejection is maintained as set forth in the prior office action dated 05/21/2004 and in view of the interpretation of "consisting essentially of" set forth above.
11. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murschall in view of Zanucci, Schreck, Kishida, and Ragan et al. (U54551485).
12. This rejection is maintained as set forth in the prior office action dated 05/21/2004 and in view of the interpretation of "consisting essentially of" set forth above.

Response to Arguments

13. Applicant's arguments filed 09/20/2004 have been fully considered but they are not persuasive.

14. Applicant first argues that the thickness of the cast sheet of DE '599 in the examples cited by the examiner is 4mm, and thus is outside the range required by the applicant. While the examiner acknowledges that the total thickness of the cast sheets of DE '599 in these examples is 4mm, these examples recite cast sheets comprising a core layer (3.5mm) sandwiched between 2 surface layers (0.25mm, or 250 μ). The surface layers are PET. It is these surface layers to which the examiner is referring in the office action, not the total cast sheet. It is clear from the examples that these surface layers have a thickness well within the claimed range. Accordingly this argument is unpersuasive.

15. Next, applicant argues that DE '599 does not teach or suggest various portion of the claimed invention, including the incorporation of flame retardants, biaxial orientation, and precrystallization/predrying. The examiner acknowledges and admits these deficiencies, but notes that there is no evidence on the record that establishes that the claimed precrystallization steps result in a product having materially different structure or properties than a film formed by another method. Thus, applicant's arguments with respect to the precrystallization step are not considered to be persuasive.

16. Next, applicant argues that US '804 teaches away from using 2-hydroxybenzophenones in polyester films. While the examiner acknowledges that US '804 does state that it is known that polyesters do not respond well to

hydroxybenzophenones, the reference nonetheless later lists this U.V. stabilizer in a list of stabilizers that are asserted to be useful in polyester films using them in polyester films (see column 2 line 54-column 4 line 50). Thus, this argument is unpersuasive.

17. Next applicant argues that US '048 teaches away from using phosphorous containing compounds as a sole flame retardant in a polyester film, as the reference discloses that the effect is "insufficient" when these compounds are utilized alone. The examiner respectfully disagrees. While the reference discloses that the flame retardant effect is "insufficient" when organic phosphorous compounds are utilized as the sole flame retardant in a film, all this suggests is that the level of flame retardancy desired by the reference was not obtained. This does not mean that the level of flame retardancy provided by organic phosphorous compounds alone would not be sufficient for some other application. Further, this is not a teaching that using organic phosphorous compounds alone impart some negative effect to the film. Rather, it suggests that a beneficial effect (flame retardancy) is added, but that that the effect is of a lower level than that desired by that specific reference when the compound is utilized alone. Thus, this argument is unpersuasive.

18. Applicants then assert that there would be no motivation to combine DE '599 with US '804 and US '048 in the manner suggested by the examiner, as these reference are in different fields of endeavor and address different problems. Applicant's argument breaks down into a non-analogous art type argument and a motivation type argument.

19. In response to applicant's argument that the cited references are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's

endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, all of the cited references are concerned with modifying the properties of polyester thin films, either through physical modification (i.e. biaxial orientation) or through the addition of additives (heat stabilizers, U.V. stabilizers etc.). The instant invention is concerned with obtaining a PET film having specified physical properties (biaxial orientation, transparency) and composition (comprising U.V. stabilizer and flame retardant). Thus, the examiner maintains that the cited art is in the same field of endeavor as that of the instant application.

20. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, there is clear motivation to combine the references in the manner suggest by the examiner. The motivations for doing so are clearly set forth at sections 9 and 12 of the office action dated 05/21/2004. Thus, this argument is unpersuasive.

21. Applicant then asserts that even if DE '599, US '804, and US '048 were combined, the claimed invention would not result. Specifically, applicant asserts that the

advantageous U.V. stabilizers of claim 19 and the precrystallized masterbatches of claim 20 would not result. Given that Murschall teaches the same U.V. stabilizers as those listed in the specification, applicant's argument with respect to the U.V. stabilizers of claim 19 is unpersuasive. Regarding the masterbatch argument, the examiner maintains, and will continue maintain in the absence of evidence to the contrary, that the properties of the claimed invention will result simply from the combination of a biaxially oriented polyester, a U.V. stabilizer meeting applicant's claim requirements, and a organic phosphorous compound such as Dimethyl Methyl Phosphonate. Applicant has presented no evidence to refute this assertion. Applicants own specification provides no evidence to support a conclusion that the claimed properties result from the use of a precrystallization masterbatch. In other words, applicant's argument is based on an uncorroborated self-serving assertion.

22. Applicant's argument is ultimately one of unexpected results. However, an argument of unexpected results cannot be considered persuasive until those results are actually shown to be unexpected. Those results cannot be shown to be unexpected without some showing that establishes that they do not necessarily result from a composition meeting the claimed composition. While the examiner does note that US practice does not require actual or comparative examples to meet the 35 U.S. 112 enablement, best mode, and written description requirements, the question here is not one of whether the application meets U.S. requirements. Rather, the question is one of distinguishing prior art from the instant invention. While the applicant can certainly opt to not provide evidence that the claimed properties arise from the manner in which the

claimed invention was made, should they do so the examiner cannot consider their argument (that the precrystallization/predrying method used to form the invention has an impact on the end product) to be persuasive.

23. Applicants remaining arguments are substantially the same as those made above, in that they either argue: 1) That the references cited by the examiner are non-analogous art; 2) There would be no motivation to combine the references in the manner suggested by the examiner; and 3) Even if there were motivation to make the asserted combination, the claimed invention would not result because the references do not suggest precrystallization/predrying. The "non-analogous art" and "claimed invention" arguments are addressed by the arguments above and are considered to be unpersuasive.

24. The motivation argument is considered to be unpersuasive because there is clear motivation to combine the references as suggested by the examiner. Those motivations are clearly stated at sections 25, 30, 39, and 43 of the prior office action dated 05/21/2004.

25. Accordingly, all of applicant's arguments are considered to be unpersuasive.

Conclusion

26. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

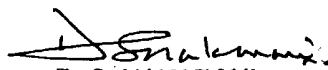
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikolas J. Uhlir whose telephone number is 571-272-1517. The examiner can normally be reached on Mon-Fri 7:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on 571-272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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D. S. NAKARANI
PRIMARY EXAMINER